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09/381,334	11/18/1999	KARI VIRTANEN	PM264014	3837

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EXAMINER

IQBAL, KHAWAR

ART UNIT PAPER NUMBER

2686

DATE MAILED: 05/06/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/381,334

Applicant(s)

VIRTANEN, KARI

Examiner

Khawar Iqbal

Art Unit

2686

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 03 February 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

***Claim Rejections - 35 USC § 101***

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 6-12 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The language of the claim raises in a question as to whether the claim is directed merely to an abstract idea that is not tied to a technological art, environment or machine which would result in a practical application producing a concrete, useful, and tangible result to from the basis of statutory subject matter under 35 U.S.C. 101.

Claims 6-12 are, claims the non-statutory matter of a program. Data structures not claimed as embodied in computer-readable media are descriptive material per se and are not statutory because they are not capable of causing functional change in the computer. See e.g., Warmerdam, 33 F. 3d at 1361, 31USPQ2d at 1754 (claim to a data structure per se held non-statutory). Therefore, since the claimed programs are not tangibly embodied in physical medium and encoded on a computer-readable medium then the Applicants has not complied 35 U.S.C 101.

***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 8-10,11 and 12 rejected under 35 U.S.C. 102(e) as being unpatentable by Amin et al (6560455).

4. Regarding claim 8 Amin et al teaches a data structure which comprises (abstract, figs. 1-5)

mobile subscriber data in a telecommunications system which supports a first and a second network the mobile subscriber data comprising address information for accessing the mobile subscriber via the first and second network (col. 6, line 33-col. 7, line 17);

a subscriber-specific access parameter (roaming restriction per MSC (rrm list, time specification, fig.))) which indicates, independently of address information (MIN/ESN, fig. 4) whether the mobile subscriber is entitled to use the first network, the second network or both networks (col. 6, line 33-col. 7, line 17).

Regarding claim 9 Amin et al teaches wherein the data structure is located in a home location register of the telecommunications system (col. 6, line 33-col. 7, line 17, HLR 66, fig. 2).

Regarding claim 10 Amin et al teaches wherein the data structure is located in the memory of the mobile station (col. 6, line 33-col. 7, line 17).

Regarding claim 12 Amin et al teaches wherein the data structure is located Subscriber Identity Module of the mobile station (col. 6, line 33-col. 7, line 17).

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-7, 11 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Josse et al (6104929) and further in view of Amin et al (6560455).

Regarding claim 1 Josse et al teaches a method of registration in a telecommunications system by a mobile station, which system comprises a home location register for maintaining subscriber data and supports a first network, and a second network, the method comprising: (figs. 1-5):

maintaining the mobile subscriber data in the home location register, and sending, from another network element, a message to the home location register for requesting the mobile subscriber data (col.7, lines 23-47, col.6, line 25-col. 7 line 30),

the home location register maintaining an access parameter which indicates whether the mobile subscriber is entitled to use the first network, the second network or both networks (col. 8, lines 6-20, col. 6, lines 25-65);

in response to said message for requesting the subscriber data, the home location register sending the mobile subscriber data and also said access parameter (col.7, lines 23-45, col. 8, line 60-col.9, line 10);

the network element that requested the mobile subscriber data using said access parameter for restricting the access of the mobile subscriber only to the first network or to the second network (col.8, lines 6-20, col. 6, lines 49-67,col. 14, lines 25-50). Josse et al does not specifically teach a subscriber-specific access parameter and independently of address information.

In an analogous art, Amin et al teaches a subscriber-specific access parameter and independently of address information (col. 6, line 33-col. 7, line 17). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the device of Josse et al by specifically adding features in order to enhance a subscriber-specific access parameter and independently of address information to increasing the efficiency of the communication system for registry procedure as taught by Amin et al.

Regarding claim 2 Josse et al teaches a method of registration in a telecommunications system by a mobile station, which system comprises home location register for maintaining subscriber data and supports a first network, and a second network, (figs. 1-5) the method comprising:

storing mobile subscriber data in the memory of a mobile station, mobile subscriber data and an access parameter indicating whether the mobile subscriber is

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entitled to use the first network, the second network or both networks (col. 10, lines 45-65, col. 6, lines 15-67); and

the mobile station using said access parameter to restrict the access of the mobile subscriber only to the first and/or the second network (col. 6, lines 49-67, col. 8, lines 6-20, col. 7, lines 20-30). Josse et al does not specifically teach a subscriber-specific access parameter and independently of address information.

In an analogous art, Amin et al teaches a subscriber-specific access parameter and independently of address information (col. 6, line 33-col. 7, line 17). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the device of Josse et al by specifically adding features in order to enhance a subscriber-specific access parameter and independently of address information to increasing the efficiency of the communication system for registry procedure as taught by Amin et al.

Regarding claim 3 Josse et al teaches the mobile subscriber's access can be restricted only to one network even though a short message service had been defined for the mobile subscriber (col. 15, lines 45-50,col. 16, lines 60-65).

Regarding claims 4-6 Josse et al teach wherein the network element that requested the mobile subscriber data uses said access parameter to prevent location updating in a network which the mobile subscriber is not entitled to use (col. 6, lines 15-35, col. 7, lines 22-60).

Regarding claims 7,11 Josse et al teach first network is a circuit-switch and second is packet-switched (col.6, lines 50-65, col. 11, lines 11-35).

***Response to Arguments***

1. Applicant's arguments with respect to claims 1-13 have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***


Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Khawar Iqbal whose telephone number is (571) 272-7909.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, **Marsha D. Banks-Harold** can be reached on (571) 272-7905. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free) or 703-305-3028.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist/customer service whose telephone number is (571) 272-2600.

*Khawar Iqbal*

  
**RAFAEL PEREZ-GUTIERREZ**  
**PATENT EXAMINER**  
4/24/05